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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,290	12/11/2000	George Bradley Hobbs	10003973-1	3711

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

YOUNG, JOHN L

ART UNIT PAPER NUMBER

3622

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/734,290

Applicant(s)

HOBBS, GEORGE BRADLEY

Examiner

John L Young

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MLB

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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FIRST ACTION REJECTION

DRAWINGS

1. This application has been filed with drawings that are considered informal; however, said drawings are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

CLAIM REJECTIONS — 35 U.S.C. §103(a)

REJECTIONS MAINTAINED

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-37 are rejected under 35 U.S.C. §103(a) as being obvious over Motamed US 6,519,053 (02/11/2003) [US f/d: 10/19/2000] (herein referred to as "Motamed").

As per claim 1, Motamed (FIG. 2; FIG. 3; FIG. 5B; FIG. 7A; FIG. 9; FIG. 10A; FIG. 10B; FIG. 10C; FIG. 11; FIG. 12A; FIG. 12B; FIG. 12C; FIG. 1A; FIG. 1B; FIG. 1C; FIG. 1D; FIG. 1E; col. 3, ll. 23-35; col. 13, ll. 12-32 and whole

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document) shows "A method of processing a print job of a customer and directing advertising to the customer, the method comprising: defining a print processing system controller having an advertisement registered therewith; defining a network communication link between the customer and the print processing system controller; processing a job ticket for the print job with the print processing system controller; and presenting the advertisement to the customer via the network communication link when the print processing system controller processes the job ticket for the print job."

Motamed lacks an explicit recitation of "presenting the advertisement to the customer via the network communication link when the print processing system controller processes the job ticket for the print job. . . ." even though Motamed (col. 3, ll. 23-35) suggests the same.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Motamed (col. 3, ll. 23-35) would have been modified and selected in accordance with "presenting the advertisement to the customer via the network communication link when the print processing system controller processes the job ticket for the print job. . . ." because such modification/selection of the disclosure of Motamed (col. 3, ll. 23-35) would have provided means for directing advertising and promotional literature to customers via the Internet. (See Motamed (col. 3, ll. 23-35)).

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As per claims 2-10 & 35, Motamed shows the elements and limitations of claim 1 and subsequent claims depending from claim 1. Motamed (FIG. 2; FIG. 3; FIG. 5B; FIG. 7A; FIG. 9; FIG. 10A; FIG. 10B; FIG. 10C; FIG. 11; FIG. 12A; FIG. 12B; FIG. 12C; FIG. 1A; FIG. 1B; FIG. 1C; FIG. 1D; FIG. 1E; col. 3, ll. 23-35; col. 13, ll. 12-32 and whole document) suggests the elements and limitations of claims 2-10 & 35.

Motamed lacks an explicit recitation of the elements and limitations of claims 2-10 & 35 even though Motamed (FIG. 2; FIG. 3; FIG. 5B; FIG. 7A; FIG. 9; FIG. 10A; FIG. 10B; FIG. 10C; FIG. 11; FIG. 12A; FIG. 12B; FIG. 12C; FIG. 1A; FIG. 1B; FIG. 1C; FIG. 1D; FIG. 1E; col. 3, ll. 23-35; col. 13, ll. 12-32 and whole document) suggests same. It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Motamed (FIG. 2; FIG. 3; FIG. 5B; FIG. 7A; FIG. 9; FIG. 10A; FIG. 10B; FIG. 10C; FIG. 11; FIG. 12A; FIG. 12B; FIG. 12C; FIG. 1A; FIG. 1B; FIG. 1C; FIG. 1D; FIG. 1E; col. 3, ll. 23-35; col. 13, ll. 12-32 and whole document) would have been modified and selected in accordance with the elements and limitations of claims 2-10 & 35 because such modification/selection of the disclosure of Motamed (col. 3, ll. 23-35) would have provided means for directing advertising and promotional literature to customers via the Internet. (See Motamed (col. 3, ll. 23-35)).

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As per claim 11, Motamed (FIG. 2; FIG. 3; FIG. 5B; FIG. 7A; FIG. 9; FIG. 10A; FIG. 10B; FIG. 10C; FIG. 11; FIG. 12A; FIG. 12B; FIG. 12C; FIG. 1A; FIG. 1B; FIG. 1C; FIG. 1D; FIG. 1E; col. 3, ll. 23-35; col. 13, ll. 12-32 and whole document) shows "A method of processing a print job of a customer and directing advertising to the customer, the method comprising: defining a print processing system controller having an advertisement registered therewith; defining a network communication link between the customer and the print processing system controller; processing a job ticket for the print job with the print processing system controller and selecting at least one of the advertisements based on the job ticket; and presenting the at least one of the advertisements to the customer via the network communication link."

Motamed lacks an explicit recitation of "presenting the advertisement to the customer via the network communication link. . . ." even though Motamed (col. 3, ll. 23-35) suggests the same.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Motamed (col. 3, ll. 23-35) would have been modified and selected in accordance with "presenting the advertisement to the customer via the network communication link. . . ." because such modification/selection of the disclosure of Motamed (col.

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3, ll. 23-35) would have provided means for directing advertising and promotional literature to customers via the Internet. (See Motamed (col. 3, ll. 23-35)).

As per claims 12-20 & 36, Motamed shows the elements and limitations of claim 11 and subsequent claims depending from claim 11. Motamed (FIG. 2; FIG. 3; FIG. 5B; FIG. 7A; FIG. 9; FIG. 10A; FIG. 10B; FIG. 10C; FIG. 11; FIG. 12A; FIG. 12B; FIG. 12C; FIG. 1A; FIG. 1B; FIG. 1C; FIG. 1D; FIG. 1E; col. 3, ll. 23-35; col. 13, ll. 12-32 and whole document) suggests the elements and limitations of claims 12-20 & 36.

Motamed lacks an explicit recitation of the elements and limitations of claims 12-20 & 36 even though Motamed (FIG. 2; FIG. 3; FIG. 5B; FIG. 7A; FIG. 9; FIG. 10A; FIG. 10B; FIG. 10C; FIG. 11; FIG. 12A; FIG. 12B; FIG. 12C; FIG. 1A; FIG. 1B; FIG. 1C; FIG. 1D; FIG. 1E; col. 3, ll. 23-35; col. 13, ll. 12-32 and whole document) suggests same. It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Motamed (FIG. 2; FIG. 3; FIG. 5B; FIG. 7A; FIG. 9; FIG. 10A; FIG. 10B; FIG. 10C; FIG. 11; FIG. 12A; FIG. 12B; FIG. 12C; FIG. 1A; FIG. 1B; FIG. 1C; FIG. 1D; FIG. 1E; col. 3, ll. 23-35; col. 13, ll. 12-32 and whole document) would have been modified and selected in accordance with the elements and limitations of claims 12-20 & 36

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because such modification/selection of the disclosure of Motamed (col. 3, ll. 23-35) would have provided means for directing advertising and promotional literature to customers via the Internet. (See Motamed (col. 3, ll. 23-35)).

As per claim 21, Motamed (FIG. 2; FIG. 3; FIG. 5B; FIG. 7A; FIG. 9; FIG. 10A; FIG. 10B; FIG. 10C; FIG. 11; FIG. 12A; FIG. 12B; FIG. 12C; FIG. 1A; FIG. 1B; FIG. 1C; FIG. 1D; FIG. 1E; col. 3, ll. 23-35; col. 13, ll. 12-32 and whole document) shows "A system for processing a print job of a customer and directing advertising to the customer, the system comprising: a print processing system controller configured to have an advertisement registered therewith; wherein the print processing system controller is adapted to process a job ticket for the print job and present the advertisement to the customer when the print processing system controller processes the job ticket for the print job."

Motamed lacks an explicit recitation of "and present the advertisement to the customer when the print processing system controller processes the job ticket for the print job. . . ." even though Motamed (col. 3, ll. 23-35) suggests the same.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Motamed (col. 3, ll. 23-35)

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would have been modified and selected in accordance with “and present the advertisement to the customer when the print processing system controller processes the job ticket for the print job. . . .” because such modification/selection of the disclosure of Motamed (col. 3, ll. 23-35) would have provided means for directing advertising and promotional literature to customers via the Internet. (See Motamed (col. 3, ll. 23-35)).

As per claims 22-34 & 37, Motamed shows the elements and limitations of claim 21 and subsequent claims depending from claim 21.

Motamed (FIG. 2; FIG. 3; FIG. 5B; FIG. 7A; FIG. 9; FIG. 10A; FIG. 10B; FIG. 10C; FIG. 11; FIG. 12A; FIG. 12B; FIG. 12C; FIG. 1A; FIG. 1B; FIG. 1C; FIG. 1D; FIG. 1E; col. 3, ll. 23-35; col. 13, ll. 12-32 and whole document) suggests the elements and limitations of claims 22-34 & 37.

Motamed lacks an explicit recitation of the elements and limitations of claims 22-34 & 37 even though Motamed (FIG. 2; FIG. 3; FIG. 5B; FIG. 7A; FIG. 9; FIG. 10A; FIG. 10B; FIG. 10C; FIG. 11; FIG. 12A; FIG. 12B; FIG. 12C; FIG. 1A; FIG. 1B; FIG. 1C; FIG. 1D; FIG. 1E; col. 3, ll. 23-35; col. 13, ll. 12-32 and whole document) suggests same. It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Motamed (FIG. 2; FIG. 3; FIG. 5B; FIG. 7A; FIG. 9; FIG. 10A; FIG. 10B; FIG. 10C; FIG. 11; FIG. 12A; FIG. 12B; FIG.

12C; FIG. 1A; FIG. 1B; FIG. 1C; FIG. 1D; FIG. 1E; col. 3, ll. 23-35; col. 13, ll. 12-32 and whole document) would have been modified and selected in accordance with the elements and limitations of claims 22-34 & 37 because such modification/selection of the disclosure of Motamed (col. 3, ll. 23-35) would have provided means for directing advertising and promotional literature to customers via the Internet. (See Motamed (col. 3, ll. 23-35)).

RESPONSE TO ARGUMENTS

3. Applicant's arguments (Amendment A, paper#4, filed 12/08/2003) concerning the rejections in the prior Office Action have been considered but are not persuasive for the following reasons:

In response to Applicant's remarks that the Information disclosure Statement paper#2 had not been reviewed and initialed by the Examiner, please find enclosed said Information disclosure Statement initialed by the Examiner of record of the instant application.

In response to Applicant's remarks that formal drawings paper#5 have been submitted to replace the informal drawings submitted with the application initially, said drawing have been entered; however note: The review process for drawings that

are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365. Therefore, the drawings characterized by Applicant as formal drawings paper#5 are deemed acceptable for examination and publication purposes but are still considered informal because the review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications.

Applicant's arguments (Amendment A, paper#4, pp. 10-12 asserts that the claims of the instant invention are patentably distinct from the prior art of record but fails to recognize that obviousness can be established by modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Applicant's arguments amount to a general allegation of patentability because Applicant's arguments fail to address the knowledge generally available to one of ordinary skill in the art at the time of the invention as pronounced in the prior Office action. In the obviousness rejections of the instant invention, the Examiner not only relies on modifying the teachings of the prior art to produce the claimed invention where

there is some suggestion to modify, the prior Office action also relies on the knowledge generally available to one of ordinary skill in the art at the time of the invention to modify the prior art to produce the invention. Therefore, claims 1-37 stand rejected pursuant to 35 USC 103(a).

CONCLUSION

4. Any response to this action should be mailed to:

Commissioner for Patents
P. O. Box 1450
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Any response to this action may be sent via facsimile to either:

(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED PROCEDURE) or
(703) 746-7239 (for formal communications marked AFTER-FINAL) or
(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh floor Receptionist
Crystal Park V
2451 Crystal Drive
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at

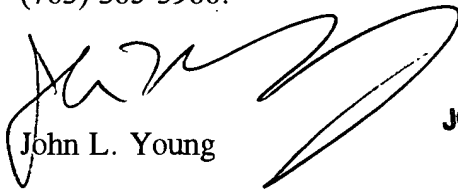
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(703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



John L. Young

**JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER**

Primary Patent Examiner

March 6, 2004